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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,709	09/18/2000	Hiroyuki Fujita	001200	4404

7590 02/24/2003

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EXAMINER
GUPTA, ANISH

ART UNIT	PAPER NUMBER
1654	

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/663,709	FUJITA, HIROYUKI	
	Examiner	Art Unit	
	Anish Gupta	1654	

-- The MAILING DATE of this communication appears on th cover sh t with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-14-02 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 6 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 5 and 6, Applicants argue that the wording "a residue of a dried fish meat extracted by hot water"means a solid portion obtained by putting fist or dried fish in a whole or part into boiling water.

Applicant's arguments filed 11-14-02 have been fully considered but they are not persuasive.

The claim is still indefinite since it is unclear as to how large or small must the portion be to render it a residue. That is would a single cell qualify as a residue or would it have to be substantially larger. The claim is indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Masayasu. (JP04069398) for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to a angiotensin converting enzyme inhibitor.

Applicants argue that the reference the reference does not disclose the method of obtaining the hydrolyzate. Further, the reference fails to account for the bitterness, color or aftertaste of the product.

As stated in the previous office actions, the reference teach an angiotensin enzyme inhibitor that has the sequence IVGRPRHQG (see abstract). Note that this peptide is same peptide claimed in claim 2, line 16, of the instant application. Although the reference does not teach the method of isolating the peptide as claimed, the claims are drawn to a product. The MPEP states that "[t]he patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from the product of the prior art, the claims is unpatentable even though the prior product was made by a different process." MPEP 2113. As for the bitterness, color, and aftertaste, the claims to not make any reference to these aspects of the product.

Rejection is maintained.

5. Claims 1-10 remain rejected under 35 U.S.C. 102(b) as being anticipated by Yokoyama et al. for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to a angiotensin converting enzyme inhibitor.

Applicants argued, in the response dated 10-19-02, that the reference does not disclose the membrane treatment of the instant application" and does not describe the "color, bitterness, and aftertaste of any hydrolyzate in several purifying steps , and is not directed to a food. . ."

However, the reference clearly states the thermo-lysing digest, implying the hydrosylate, of dried bonito does not have a bitter taste or fishy order but has a good taste (see page 1544). Thus, the reference talk about the bitterness and since it is edible qualifies as food. As for the membrane step., the claims are drawn to a food product. The reference teaches that food product. The mere fact that the reference does not teach a membrane step is inconsequential. The MPEP states that "[t]he patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from the product of the prior art, the claims is unpatentable even though the prior product was made by a different process." MPEP 2113. As for the bitterness, color, and aftertaste, the claims to not make any reference to these aspects of the product.

Rejection is maintained.

6. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Suetsuna. for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to a angiotensin converting enzyme inhibitor.

Applicants argue that the reference the reference does not disclose the method of obtaining the hydrrolyzate. Further, the reference fails to account for the bitterness, color or aftertaste of the product.

As stated in the previous office action, the reference teach an angiotensin enzyme inhibitor that has the sequence Leu-Lys-Tyr-Pro-Ile-Glu (see abstract). Note that this peptide comprises the same peptide claimed in claim 2, line 9, of the instant application. The reference further states that the peptide is obtained by hydrolysis of sardine muscle (see abstract). Although the reference does not teach the method of isolating the peptide as claimed, the claims are drawn to a product. The MPEP states that "[t]he patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from the product of the prior art, the claims is unpatentable even though the prior product was made by a different process." MPEP 2113. As for the bitterness, color, and aftertaste, the claims to not make any reference to these aspects of the product.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (703) 308-4001. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback , can normally be reached on (703)306-3220. The fax phone number of this group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Anish Gupta

February 20, 2003

BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600